

REMARKS

Initially, further to the telephone conversation between William Johnson and Examiner Witherspoon on December 11, 2002, wherein an election was required between the following groups: I) Claims 1-4, drawn to a catalyst system, classified in class 502, subclass 102; and II) Claims 5-29, drawn to a process for rearrangement of an epoxide to an allylic alcohol, classified in class 568, subclass 320, Applicants provisionally elect Group I, Claims 1-4, with traverse.

Applicants respectfully request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all the claims. M.P.E.P. § 803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (Emphasis added.)

Here, irrespective of whether the groups requested are independent and distinct inventions, the requirement should be withdrawn since the Patent Office has not shown that it would be a serious burden to search and examine all of the groups together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

Claims 1-4 are now pending in the application, Claims 5-29 have been withdrawn.

The Abstract has been replaced with a substitute Abstract to ensure compliance with the proper language and format for an abstract of the disclosure. A copy of the replacement Abstract is attached hereto on a separate sheet. Support for this amendment can be found in the original Abstract, Specification, and Claims as filed. No new matter has been added by this amendment.

In the only rejection presented in the Office Action, Claims 1-4 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by the disclosure of U.S. Patent No. 6,093,793 (hereinafter "Hofmann").

It is well established that in order for a reference to be novelty defeating, it must teach each and every feature of the claimed invention. As will be set forth below, it is respectfully submitted that the disclosure of Hoffman does not meet this standard.

Claim 1 of the instant application recites, in relevant part, a catalyst system suitable for use in the rearrangement of epoxides to allylic alcohols comprising at least one activator/modifier comprising at least one phenolic compound wherein the activator modifier is present in an amount effective to improve the activity and/or selectivity of the primary catalyst in the rearrangement of a desired epoxide to an allylic alcohol.

The disclosure of Hoffman fails to teach or even suggest a phenolic activator/modifier component effective to improve the activity and/or selectivity of the primary catalyst in the rearrangement of a desired epoxide to an allylic alcohol. Specifically, the disclosure of Hoffman is directed to a process for the preparation of **polyether polyols**. To this end, Hoffman is silent with respect to the use of a phenolic activator/modifier component in that it only discloses the possibility that a base-catalyzed rearrangement of epoxides can take place as a side-reaction and yield allyl or propenyl alcohols. See, col. 2, lines 14-28. Moreover, the Office Action incorrectly relies upon Hoffman's further disclosure that the presence of certain accelerators can be disadvantageous in a process for the production of polyether polyols because the addition of such accelerators causes a distinct increase in the undesirable side-reactions, i.e., the formation of low-molecular weight cyclic ethers. See, col. 3, lines 3-10. In fact, the disclosure of Hoffman only discloses the potential for certain accelerators to increase the rate of production of low-molecular weight **cyclic ethers**, not allylic alcohols.

Furthermore, the only mention of a phenolic containing compound within the disclosure of Hoffman is for use as a starter compound and **not** as a component of a catalyst system. See, col. 3, lines 33-46. As described therein, Hoffman discloses that the process for preparing the polyether polyol comprises the polyaddition of an alkylene oxide to a starter compound. See, col. 3, lines 11-13. Therefore, the starter compounds of Hoffman, and hence the only phenolic compound disclosed therein, are consumed in the polyaddition reaction as a reagent and, by definition, cannot be considered to be a component of a catalyst system.

Therefore, in view of the arguments set forth above, it is respectfully submitted that the disclosure of Hoffman fails to teach each and every feature recited in Claims 1-4 of the present application, and so, Applicants respectfully request that this rejection be withdrawn.

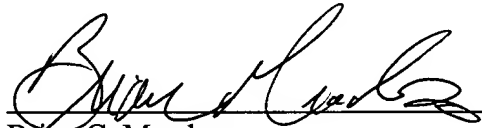
CONCLUSION

In view of the Remarks set out above, it is respectfully asserted that the rejections set forth in the Office Action of June 20, 2003 have been overcome and that the application is in condition for allowance. Therefore, Applicant respectfully seeks notification of same.

No additional fee is believed due; however, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.



Brian C. Meadows

Registration No. 50,848

Needle & Rosenberg, P.C.
999 Peachtree Street
Suite 1000
Atlanta, Georgia 30309
(678) 420-9300

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX NON-FEE AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.



Brian C. Meadows, Registration No. 50,848

8.14.03

Date

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